A-9

page.

REMARKS

Claims 1-16 have been examined and have been rejected under 35 U.S.C. § 103(a). Also,

The Examiner has objected to claims 1-16 for various informalities.

I.   Objections to specification and claims.

The Examiner has objected to the specification and claims because they contain minor

grammatical and/or idiomatic errors. Applicants have by amended the specification and claims

as shown in the attached Appendix to overcome the objections. Furthermore, the amendments to

the claims merely correct minor typographical errors and do not narrow the scope of the claims

II.   Rejection under 35 U.S.C. § 103(a) over U.S. Patent 6,229,622 to Takeda ("Takeda") and the alleged admitted prior art contained at page 1, lines 14-19, of the present application ("APA")

Claims 1-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over

Takeda in view of the alleged admitted prior art contained at page 1, lines 14-19, of the present

application ("APA").

A.   **Page 1, lines 14-19, of the application is not prior art**

Applicants submit that claims 1-16 would not have been obvious over Takeda in view of

the alleged APA because the alleged APA is not admitted prior art. In order for the information

contained at page 1, lines 14-19, to be admitted prior art, the Applicant must actually admit that

that it is in fact prior art. For example, M.P.E.P. § 2129 states:

> When applicant states that something is prior art, it is taken as being available as
> prior art against the claims. Admitted prior art can be used in obviousness
> rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975)
> (Figures in the application labeled "prior art" held to be an admission that what
> was pictured was prior art relative to applicant's invention.)

(Emphasis added). Nothing in the present application indicates that the disclosure at page 1,

lines 14-19, is prior art. For example, such disclosure is contained in a portion of the application

entitled "Description of the Related Art" and no where else in the application is the alleged APA

referred to as "prior art". Since page 1, line 14-19, is not admitted prior art, it cannot be used

against the Applicant in the present rejection, and thus, Applicants submit that the § 103(a)

rejection is improper.

B.   **The Examiner is improperly relying on hindsight motivation to combine the
teachings of Takeda and the APA**

In addition, Applicants submit that the Examiner is using hindsight in combining the

teachings of the Takeda reference and the alleged APA. "[O]bviousness cannot be established

by combining the teachings of the prior art to produce the claimed invention, absent some

teaching, suggestion or incentive supporting the combination." In re Geiger, 2 U.S.P.Q.2d 1276,

1278 (Fed. Cir. 1987) (citing <u>ACS Hosp. Sys. v. Montefiore Hosp.</u>, 221 U.S.P.Q. 929. 933 (Fed. Cir. 1984).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." <u>Winner International Royalty Corporation v. Ching-Rong Wang</u>, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000). Conclusory statements such as common knowledge to one skilled in the art or common sense do not fulfill the agency's obligation. <u>In re Sang Su Lee</u>, 277 F.3d 1338, 1345 - 46, 61 U.S.P.Q.2d 1430, 1438 (Fed. Cir. 2002).

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (*citing In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab,* 55 USPQ2d at 1316 (*quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Hindsight has repeatedly been held to be improper and ineffective in supporting an argument of *prima facie* obviousness. *See, e.g., In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Bond*, 15 USPQ2d 1556 (Fed. Cir. 1990); *In re Laskowski* 10 USPQ2d 1397 (Fed. Cir. 1989). On the present record, the references simply do not provide the impetus to do what the

inventor did.

In the present case, one of ordinary skill in the art would not have been motivated to combine the alleged APA and Takeda for efficiency as suggested by the Examiner. The alleged APA deals with the previewing function. In particular, it discloses a method of reading and converting data to different formats such as display or print control code. In contrast, Takeda attempts to solve a problem of multiple users attempting to print data of different lengths to the same printing device. Specifically, Takeda's invention allows users with small quantities of print data not to wait for the completion of printing jobs with large quantities of print data. The problem addressed by the Takeda reference is significantly different from the problem addressed by the present invention. It is not obvious to one of ordinary skill in the art to apply an invention dealing with the problem of multiple users and/or multiple printing jobs to an invention for previewing print data. Therefore, Examiner is exercising hindsight in combining the two references.

Also, even assuming *arguendo* that the APA is in fact prior art and that one skilled in the art would have been motivated to combine the APA and Takeda, Applicants submit that the claims are still patentable over the references.

C. Claim 1

In claim 1, print data is spooled, and the spooled print data is converted into display data. Also, the display data, which is being displayed, is edited based on edited data, and the edited display data is converted into a structure of the spooled print data. On page 4 of the Office

Action, the Examiner seems to contend that the editing and previewing options displayed on the display unit 221 and described at column 9, lines 9-17, of Takeda correspond to the claimed method of editing display data. However, Applicants submit that the Examiner is misinterpreting and/or misapplying the teachings of Takeda.

For example, column 9, lines 11-14, of the reference specifically states that the display data comprises files in each spool area and function keys and states that Fig. 6 shows a display of such files and function keys. Clearly, the displayed file names and function keys are displayed on the screen, but they are not edited. Also, no suggestion exists that spooled print data is converted into the files and function keys (i.e. the alleged display data).

In addition, although column 7, lines 59-60, of Takeda mention "editing on a per-spool basis," there is absolutely no disclosure regarding what data is edited or how any data is edited. Furthermore, as shown in Fig. 6, the display unit 221 shown in Fig. 6 is merely a small panel, and one skilled in the art clearly cannot determine how any displayed data is edited, and thus, it does not suggest editing data as claimed in claim 1.

Finally, the APA merely suggests transferring spooled data, which is spooled at the host/PC. Therefore, the APA does not teach editing spooled data.

In light of the discussion above, the APA and Takeda (alone or in combination) do not suggest the claimed display data. Accordingly, Applicants submit that claim 1 would not have been obvious.

D.   Claims 2-6

Since claims 2-6 are dependent upon claim 1, Applicants submit that they are patentable

at least by virtue of their dependency.

E.   Claim 7

Since claim 7 contains features that are similar to the features recited in claim 1,

Applicants submit that claim 7 is patentable for similar reasons.

F.   Claims 8-9

Since claims 8-9 are dependent upon claim 7, Applicants submit that they are patentable

at least by virtue of their dependency.

G.   Claim 10

Since claim 10 contains features that are similar to the features recited in claim 1,

Applicants submit that it is patentable for similar reasons.

H.   Claims 11-16

Since claims 11-16 are dependent upon claim 10, Applicants submit that they are

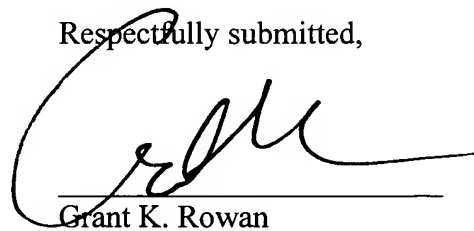patentable at least by virtue of their dependency.

III. Other Cited References

The Examiner cites additional references that have not been applied in any rejection. Applicants submit that these references are no more relevant then the references actually applied in the prior art rejection.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The specification is changed as follows:

Please amend page 1, first full paragraph, to read:

The present invention relates to a previewing method, which, in a device
having a spooling function, enables [a] print data based on a print request to be visually
checked and edited immediately before printing, a previewing device which is suitable for
implementation of the previewing method, and a recording media for causing a computer device
to execute the previewing method.

Please amend page 1, second full paragraph, to read:

Recently, part of a process in a print control which is to be performed in a
printing device such as a printer is generally performed in a host computer. For example,
the host computer converts [a] data based on a print request input from an application
program (hereinafter, referred to as "AP") into a print control code of a structure which can be
read by the printing device, spools a print control code of a structure which can
be read by the printing device, spools a print control code after conversion, and sends a
despooled (inversely spooled) print control data to the printing device.

Please amend page 2, third full paragraph, to read:

It is further object of the invention to provide [a] recording media for realizing the
previewing method or the previewing device in a general-purpose computer device.

IN THE CLAIMS:

The claims are amended as follows:

1.   (Once amended) A method of previewing a print data, comprising the steps of:

obtaining [a] print data which can be printed by a printing device, and spooling the print data into a predetermined memory;

converting the spooled print data into [a] display data of a predetermined structure, and displaying the display data on a displaying device;

editing the display data which is being displayed, on the basis of [an edition] <u>edited</u> data which is input at the display; and

inversely converting the edited display data into a structure of the spooled print data.

3.   (Once amended) A previewing method according to claim 1, wherein, when the print data consists of actual print information based on a print request and added-value information which is posteriorly added, said step of editing the display data uses only the added-value information which is being displayed, as an [edition] <u>edited</u> object.

4.   (Once amended) A previewing method according to claim 3, wherein, the added-value information is [a] template data which can be overlapping printed onto plural allocated pages, said allocated pages being allocated to one print sheet, and, when a position of the template data in one of the allocated pages is changed, the position change is reflected on the other allocated pages.

6.   (Once amended) A previewing method according to claim 3, wherein, the added-value information is [a] template data which can be overlapping printed onto plural allocated pages, said allocated pages being allocated to one print sheet, and the position of the template data in one of the allocated pages is varied, depending on whether the page is an odd page or an even page.

7.   (Once amended) A method of previewing a print data, comprising:

spooling means for spooling [a] print data which can be printed by a printing device;

data converting means for converting the spooled print data into [a] display data of a predetermined structure;

display controlling means for displaying the converted display data on a displaying device;

data editing means for editing the display data which is being displayed, on the basis of [an edition] edited data which is input at the display; and

data inversely converting means for inversely converting the edited display data into a structure of the spooled print data, and

editing means for editing visually a print data based on a print request, wherein said editing means is performed immediately before printing.

9.   (Once amended) A previewing device according to claim 7, wherein said data

editing means edits [a] display data which [is] <u>are</u> spooled and converted in a predetermined time period.

10.   (Once amended) A recording media on which program codes are recorded, wherefore said program codes are read and executed by a computer device, being connected to a printing device, having input means for a data entry and a displaying device, with causing said computer device to perform the following processes:

(1) a spool process of spooling [a] print data which can be printed by said printing device;

(2) a data conversion process of converting the spooled print data into [a] display data of a predetermined structure,

(3) a display control process of displaying the converted display data on said displaying device;

(4) a data edition process of editing the display data which is being displayed, on the basis of [an edition] <u>edited</u> data which is input at the display of said displaying device, through said input means; and

(5) data inverse conversion process for inversely converting the edited display data into a structure of the spooled print data.

14.   (Once amended) A recording media according to claim 13, wherein, the added-value information is [a] template data which can be overlapping printed onto plural allocated pages, said allocated pages being allocated to one print sheet, and, when a position of the

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template data in one of the allocated pages is changed, the position change is reflected on the

other allocated pages.

16.   (Once amended) A recording media according to claim 13, wherein, the added-

value information is [a] template data which can be overlapping printed onto plural allocated

pages, said allocated pages being allocated to one print sheet, and the position of the template

data in one of the allocated pages is varied depending on whether the page is an odd page or an

even page.